

ESTTA Tracking number: **ESTTA508714**

Filing date: **12/03/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	85262306
Applicant	Saga Swimwear LLC
Applied for Mark	SAGA
Correspondence Address	VERONIQUE KHERIAN HIGA & GIPSON LLP 510 NEW MONTGOMERY STREET , SUITE 510 SAN FRANCISCO, CA 94105 UNITED STATES vkherian@higagipsonllp.com, gipson@higagipsonllp.com, higa@higagipsonllp.com
Submission	Reply Brief
Attachments	SAGA Reply Brief.pdf (5 pages)(1221181 bytes)
Filer's Name	Veronique Kherian
Filer's e-mail	vkherian@higagipsonllp.com, gipson@higagipsonllp.com, higa@higagipsonllp.com
Signature	/Veronique Kherian/
Date	12/03/2012

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Matter:
Applicant:
Mark:

In re Saga Swimwear, LLC
Saga Swimwear, LLC



Serial No.:
Filed:
Class:
Examining Attorney

85262306
March 9, 2011
025
Erin Falk
Law Office 101

APPLICANT'S BRIEF IN REPLY TO THE
EXAMINING ATTORNEY'S APPEAL BRIEF

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

INTRODUCTION

Saga Swimwear, LLC, (“Applicant”) submits this reply to the Examining Attorney’s Appeal Brief mailed November 14, 2012, and respectfully requests that the Trademark Trial and Appeal Board reverse her refusal to register the above-referenced mark.

COMPARISON OF THE MARKS

The Examining Attorney has argued that the letter/word portion of Applicant’s composite mark should be accorded greater weight in determining whether its mark is confusingly similar to that of Registrant.

Applicant respectfully disagrees with this analytical framework. The Court of Appeals for the Federal Circuit has made it clear that in a likelihood of confusion analysis “[t]here is no general rule as to whether letters or designs will dominate in composite marks; nor is the dominance of letters or design dispositive of the issue.” *In re Electrolyte Labs. Inc.*, 929 F.2d 645, 647, 16 USPQ2d 1239, 1240 (Fed. Cir. 1990). The comparison of composite marks must be done on a case-by-case basis, without reliance on mechanical rules of construction. *See, e.g., Spice Islands, Inc. v. Frank Tea & Spice Co.*, 505 F.2d 1293, 184 USPQ 35 (C.C.P.A. 1974) (reversing TTAB’s holding that SPICE TREE with tree design, for garlic powder and minced onion, and SPICE ISLANDS with and without tree design, for seasoning herbs and spices, is not likely to cause confusion).

In this case, Applicant’s mark is distinct from Registrant’s mark because it is dominated by a large sailboat design consisting of large, rose gold sails with black, stylized text making up the boat underneath. The bright color of the sails emphasizes the sail design while simultaneously de-emphasizing the black text. Although the Examining Attorney relies heavily on the presence of the word “SAGA” as grounds for her refusal, the design element of

Applicant's mark confers a specific connotation related specifically to sailing and water that is noticeably absent in Registrant's mark.

Consequently, the Examining Attorney should find that the design portion of Applicant's mark should be conferred greater weight in a likelihood of comparison analysis.

COMPARISON OF CHANNELS OF TRADE AND MARKETING

The Examining Attorney has argued that the goods of Applicant and Registrant are likely to be encountered by consumers in similar trade channels, thus supporting a finding of likelihood of confusion. To support her finding, the Examining Attorney refers to large retail brand websites such as REI, Ralph Lauren, J.Crew, Oakley, and LL Bean, pointing out that these websites each sell both outerwear and swimwear. The Examining Attorney also refers to her final refusal and registration information from lesser-known marks containing descriptions for a wide variety of clothing.

Applicant respectfully disagrees with this finding that consumers are likely to encounter Applicant's and Registrant's goods in the same channels of trade. The large-scale brands (REI, Ralph Lauren, LL Bean, etc.) the Examining Attorney uses in her comparison are ubiquitous, often having entire stores devoted to their many products. In contrast, Applicant is a small-scale, boutique operation that markets its products to independent, educated, fashion-conscious, young, urban women who enjoy foreign travel. Applicant expresses a strong commitment to high fashion and luxury. On the other hand, Registrant markets its products to a primarily male demographic focused on rugged, functional outerwear. Each party has distinct marketing focuses, minimizing the likelihood that consumers will encounter them together and become confused as to origin of their respective goods.

The Examining Attorney's listing of third-party registrations consisting of some smaller boutiques offering apparel, offered as evidence of likelihood of confusion, again, does not take into account the Applicant's distinct target demographics and marketing focuses. Given the distinctiveness of Applicant's marketing objectives, it is highly unlikely that consumers will encounter both marks in similar channels of trade.

CONCLUSION

For the reasons set out above, Applicant respectfully requests that Applicant's composite mark for "Beach cover-ups; Beach coverups; Beachwear; Swimwear" be permitted to proceed to registration because it is not likely to be confused with the registered mark SAGA for "Wearable garments and clothing not comprised in whole, or in part, of fur, namely, jackets, pants, ski-suits, shirts, hats, bandannas, sweatshirts and hooded sweatshirts, all for use in winter sports, including but not limited to, skiing and snowboarding."

Dated: December 3, 12

Respectfully submitted,



Veronique Kherian
HIGA & GIPSON, LLP
510 New Montgomery Street Suite 510
San Francisco, California 94105
(415) 692-6520 ext. 109 (telephone)
(415) 692-6522 (facsimile)
vkherian@higagipsonllp.com

Attorneys for Applicant

Certificate of Filing

I hereby certify that this correspondence is being filed with the United States Patent & Trademark Office via the Trademark Trial and Appeal Board's Electronic System for Trademark Trials and Appeals online filing process.

12/3/2012
Date of Deposit


Signature

12/3/2012
Date of Signature